



UNITED STATES PATENT AND TRADEMARK OFFICE

CLV
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/984,476	12/03/1997	M MICHAEL WOLFE	34477.2	2213
21874	7590	11/10/2005	EXAMINER	
EDWARDS & ANGELL, LLP			ROMEO, DAVID S	
P.O. BOX 55874			ART UNIT	PAPER NUMBER
BOSTON, MA 02205			1647	

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/984,476	WOLFE ET AL.	
Examiner	Art Unit		
David S. Romeo	1647		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 August 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 93,95-98 and 105-130 is/are pending in the application.
4a) Of the above claim(s) 93,95-98 and 105-116 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 117-122, 124-129 is/are rejected.

7) Claim(s) 118-122 and 127-130 is/are objected to.

8) Claim(s) 93,95-98 and 105-130 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) 5 has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/25/2005 has been entered.

Claims 93, 95–98 and 105–130 are pending. Claims 93, 95–98, 105–116 and 123 are withdrawn from consideration as being drawn to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. See the last Office action at page 2, line 5 through page 5, line 2.

10 Claims 117–122 and 124–130 are being examined.

New Formal Matters, Objections, and/or Rejections:

Double Patenting

Applicant is advised that should claim 118 be found allowable, claim 130 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an 15 application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

Claim 120 is objected to under 37 CFR 1.75(c) as being in improper form because a 20 multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n). Claims 121 and 122 depend from claim 120. Hence, they share this defect in form

with claim 120 and are also objected to under 37 CFR 1.75(c) as being in improper form.

Accordingly, claims 120–122 have not been further treated on the merits.

Claims 118–122 and 127–130 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The polypeptide with the indicated substitutions (claims 118–122 and 127–130) does not further limit a polypeptide consisting essentially of SEQ ID NO: 5.

Applicants argue that the claims properly depend on claim 117 because they retain the same basic and novel characteristics. Applicant's arguments have been fully considered but they are not persuasive. As noted by Applicants, the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. The basic and novel characteristic of claim 117 is SEQ ID NO: 5. Claims 118–122 and 127–130 do not retain SEQ ID NO: 5. Claims 118–122 and 127–130 do not limit the scope of the claims to SEQ ID NO: 5 — the material specified in claim 117.

Claim Rejections - 35 USC § 112

Claims 124–129 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Support for the indicated substitutions in claims 124–129 cannot be found in the disclosure as originally filed, which raises the issue of new matter:

5

Claims 117–122 and 127–130 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a 10 claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Applicants use the term “consisting essentially of SEQ ID NO: 5” in claim 117 to mean that substitutions in 15 SEQ ID NO: 5 are permitted, while the accepted meaning is “the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention.” The term is indefinite because the specification does not clearly redefine the term.

Claims 118–122 and 127–130 depend from claim 117 and share this defect with claim 117. Hence, these claims are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

20

Conclusion

No claims are allowable.

Art Unit: 1647

FRIDAY FROM 7:30 A.M. TO 4:00 P.M. IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, BRENDA BRUMBACK, CAN BE REACHED ON (571) 272-0961.

IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE CENTRAL FAX NUMBER FOR OFFICIAL CORRESPONDENCE, WHICH IS (571) 273-8300.

5 CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.

10



15 DAVID ROMEO
PRIMARY EXAMINER
ART UNIT 1647

DSR
NOVEMBER 8, 2005